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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,943	05/13/2005	Craig B Gentry	6655P008	1694
8791 7590 04/27/2009 BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP 1279 OAKMEAD PARKWAY SUNNYVALE, CA 94085-4040				
EXAMINER				
WORJLOH, JALATIE				
ART UNIT		PAPER NUMBER		
3685				
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04/27/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/534,943

Applicant(s)

GENTRY ET AL.

Examiner

Jalatee Worjloh

Art Unit

3685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This Office Action is responsive to the amendment filed January 30, 2009.
2. Claims 1 and 4-24 are pending.

Response to Arguments

3. Applicants' arguments filed January 30, 2009 have been fully considered but they are not persuasive.
4. As per claims 13 and 22, 35 USC 112 rejection, Applicants direct the Examiner to paragraphs in the specification describing an accounting process, when the process occurs, and payments, etc. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
5. Applicant argues that Uzo and Merkle fail to teach "providing one or more tokens to the foreign service provider with a next packet when the foreign service provider accepts the signature to use the service, wherein the one or more tokens are generated using the hash tree".

However, the Examiner respectfully disagrees, and notes that the claim recites the optional/conditional element "when". Although the conditional elements have been considered, Applicant is reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See MPEP §2106 II. C: "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]"

Also, the claim "to use the service" is considered functional language.

The claim recites the functional language for. Applicant is reminded that functional recitation(s) using the word “for” or other functional language (“to use the service”) have been considered but given less patentable weight because they fail to add any steps and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.).

Functional recitation(s) using the word “for” or other functional language (e.g. “to use the service”) have been considered but are given little patentable weight¹ because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) (“The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself.”); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

¹ See e.g. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight).

Priority

6. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in PCT/US2004/003438 on 2/6/20004 (see Oath and Declaration). It is noted, however, that applicant has not filed a certified copy of the application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claims 1 and 24 rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: verifying the signature by the service provider.

10. Claims 14 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: the service provider verifying the signature.

11. Claims 1, 14, 23, 23, and 24 recite providing one or more tokens to the foreign service provider with a next packet when the foreign service provider accepts the signature; however, it unclear how the provider accepts the signature. Is the provider verifying the signature?

12. Claims 1, 14, 23, and 24 recite continuing to use the service while the foreign service provider accepts tokens. However, the service was not initialed utilized; that is, only a request was made.

13. Claim 13 recites "informing the home service provider of the monetary value of the dense hash". How is implemented?

14. Also, claim 13 recites "providing payments based on the tree to the foreign service provider", are these payments the same as the token, which Specification describes as microcredit tokens? Claim 1 recites the conditional element "when", which implies that the payment/token does not have to be provided to the foreign service provider. If it is not provided then this step would not be possible.

15. As per claim 22, it is unclear when these steps occur. In claim 1, a signature is generated on a root value of the hash tree and the signature and the value is sent to the foreign service provider. Claim 14, provides the root value to a home service provider for signature; is the signature that was previously generated?

16. Claim 22 recites "informs the home service provider of the monetary value of the dense hash." How is this implemented?

17. Also, claim 22 describes providing payments based on the tree to the foreign service provider, are these payments the same as the token, which Specification describes as microcredit tokens? Claim 1 recites the conditional element "when", which implies that the payment/token does not have to be provided to the foreign service provider. If it is not provided then this step would not be possible.

18. As per the method claims, please indicate which device is controlling each step within

the body of the claims.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 1 and 7-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Publication No. 2003/0061170 to Uzo in view of U.S. Patent No. 4309569 to Merkle.

Referring to claim 1, Uzo discloses requesting a desired service through a foreign service provider (paragraph [0215]), sending a digital signature and a root value to the foreign service provider (see paragraph [0141] - the token has the signature), providing one or more tokens to the foreign service provider with the next packet if the foreign service provider accepts the signature and continuing to use the service while the foreign service provider accepts tokens (see paragraph [0215]). Uzo does not expressly disclose generating a hash tree and generating a digital signature on a root value of the hash tree. Merkle discloses generating a hash tree and generating a digital signature on a root value of the hash tree (see claim 1). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Uzo to include the features of Merkle. One of ordinary skill in the art would have been motivated to do this because it provides a means for authenticating messages (see Merkle, abstract).

Although the conditional elements have been considered, Applicant is reminded that

optional or conditional elements do not narrow the claims because they can always be omitted. See MPEP §2106 II. C: "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]"

As per claims 7-13, Uzo in view of Merkle discloses this concept (see claim 1 rejection above).

Claims 14-24 are rejected on the same rationale as claims 1-3 and 7-13 above.

Allowable Subject Matter

21. Claims 4-6 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph [and other informalities] set forth in this Office action.

22. Although Applicant(s) use "means for" in the claim(s) (*e.g.* claims 20-24), it is the Examiner's position that the "means for" phrase(s) do not invoke 35 U.S.C. §112 6th paragraph. If Applicant(s) concur, the Examiner respectfully requests Applicant(s) to either amend the claim(s) to remove all instances of "means for" from the claim(s), or to explicitly state on the record why 35 U.S.C. §112 6th paragraph should not be invoked. Alternatively, if Applicant(s) desire to invoke 35 U.S.C. §112 6th paragraph, the Examiner respectfully requests Applicant(s) to expressly state their desire on the record. Upon receiving such express invocation of 35 U.S.C. §112 6th paragraph, the "means for" phrase(s) will be interpreted as set forth in the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6th*.² Failure by Applicant(s) in their next response to also address the 35 U.S.C. §112 6th paragraph issues in accordance with 37 C.F.R. §1.111(b) or to be non-responsive to this issue entirely will be

² Federal Register, Vol 65, No 120, June 21, 2000.

considered a desire by Applicant(s) NOT to invoke 35 U.S.C. §112 6th paragraph. Unless expressly noted otherwise by the Examiner, the preceding discussion on 35 U.S.C. §112 6th paragraph applies to all examined claims currently pending.

Conclusion

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 571-272-6714. The examiner can normally be reached on Monday - Friday 10:00 - 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt II can be reached on 571-272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jalatee Worjloh/
Primary Examiner, Art Unit 3685